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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,524	09/08/2003	Daryl S. Meredith	TN-3481	9167

7590
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01/04/2007

EXAMINER

DEXTER, CLARK F

ART UNIT

PAPER NUMBER

3724

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/657,524

Applicant(s)

MEREDITH, DARYL S.

Examiner

Clark F. Dexter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 17 is/are pending in the application.
- 4a) Of the above claim(s) 2-5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,6-9 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 29, 2006 has been entered.

Claim Objections

2. Claims 1, 6-9 and 17 are objected to because of the following informalities:

In claim 1, line 14, it seems that a comma --,-- is missing after "removed" or the like.

In claim 17, it is noted that the status of the claim is inaccurate, and it should read --previously presented-- or the like.

Appropriate correction is required.

Claim Rejections - 35 USC § 112, 1st paragraph

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 6-9 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The original disclosure does not provide support for the limitation "an auxiliary fence disposed ... above a portion of the fixed fence" as now set forth in claim 1, lines 12-13. Rather, support is provided for the auxiliary fence 23 being disposed behind the fixed fence 21 as shown in Figures 3 and 4.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by European Publication 0 752 300 (hereafter EP '300).

EP '300 discloses a saw (e.g., see Figs. 1-13 and 21) with every structural limitation of the claimed invention including:

a base (e.g., 12) for supporting a workpiece;

a saw assembly (e.g., see col. 6, line 35 - col. 7, line 1) connected to the base, the saw assembly comprising a pivot arm, an upper blade guard (e.g., 18) connected to

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the pivot arm, a motor (e.g., 20) attached to the upper blade guard, and a blade (e.g., 16) driven by the motor, the saw assembly being movable between an upper position for not engaging the workpiece, and a lower position for engaging the workpiece (e.g., by the pivot located immediately below the motor 20 as viewed in Figure 1); and

a fence assembly attached to the base and disposed to one side of the blade, the fence assembly comprising a fixed fence fixedly (e.g., 48) attached to the base and disposed on the one side of the blade, a movable fence (e.g., 60) removably connected to the fixed fence (e.g., as shown in Figure 5) and disposed on the one side of the blade, the movable fence defining a first support plane, at least one of the fixed fence and the movable fence for contacting the workpiece, and an auxiliary fence (e.g., 80) disposed on the one side of the blade behind at least one of the fixed fence and the movable fence, and above a portion of the fixed fence (e.g., to the same extent as the present invention meets this limitation), the auxiliary fence defining a second support plane substantially parallel to the first support plane, so that when the movable fence (e.g., 60) is removed, no portion of the fence assembly (e.g., 48, 60) is above the fixed fence (e.g., 48) and in front of the second support plane, allowing the auxiliary fence to contact the workpiece (e.g., the auxiliary fence 80 is fully capable of contacting a workpiece when the movable fence 60 is removed).

It is noted that various types of workpieces will meet this claim; for example, an irregular shaped workpiece, a stepped workpiece, a generally L-shaped workpiece or the like, that includes a portion that rests on the workpiece support surface and another

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portion that extends to contact portion 80. Further, it is noted that component 60 could be pivoted out of the way of the workpiece so that the workpiece may contact surface 80, or it could be removed (or not installed at all) as suggested in col. 7, lines 31-32. It is emphasized that all of the above-described manipulations, including selection of workpiece configurations, can be performed without modifying the prior art device as disclosed in the prior art document, and thus are considered to be functional recitations of intended use of the prior art device.

Regarding claims 6-9, EP '300 discloses the saw with every structural limitation of the claimed invention as further defined including

[claim 6] wherein the fixed fence has a support surface (e.g., at 107);

[claim 7 (from 6)] wherein the support surface is substantially parallel to an upper surface of the base;

[claim 8 (from 6)] wherein the support surface is substantially perpendicular to the first support plane;

[claim 9] wherein the fixed fence has a surface (e.g., 63) which is substantially coplanar with the first support plane.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1, 6-9 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al., pn 4,869,142 in view of O'Banion et al., pn 5,297,463 or European Publication 0 752 300 (hereafter EP '300).

Sato discloses a saw (e.g., see Fig. 9) with every structural limitation of the claimed invention including:

- a base (e.g., 1) for supporting a workpiece;

- a saw assembly connected to the base, the saw assembly comprising a pivot arm (e.g., 14), an upper blade guard (e.g., 26) connected to the pivot arm, a motor (e.g., 16) attached to the upper blade guard, and a blade (e.g., 17) driven by the motor, the saw assembly being movable between an upper position for not engaging the workpiece, and a lower position for engaging the workpiece; and

- a fence assembly (e.g., 3) attached to the base and disposed to one side of the blade, the fence assembly comprising a fixed fence fixedly (e.g., 48) attached to the base and disposed on the one side of the blade, the fixed fence for contacting the workpiece, and an auxiliary fence (e.g., 37) disposed on the one side of the blade behind the fixed fence (i.e., when adjusted in such a manner), and above a portion of the fixed fence (e.g., to the same extent as the present invention meets this limitation), the auxiliary fence defining a second support plane substantially parallel to the first support plane and allowed to contact the workpiece.

Sato lacks a movable fence. However, such movable fences are old and well known in the art and provide various well known benefits including configuring the fence assembly to correspond to a particular work piece and/or cutting operation. O'Banion et

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al. discloses one example of such a fence assembly configuration. EP '300 discloses another example of such a fence assembly configuration that clearly shows a movable fence (e.g., 32) that is removable. It is noted that claims 6-9 are met by either Sato or Sato modified by the known prior art including O'Banion or EP '300. Therefore, it would have been obvious to one having ordinary skill in the art to provide a movable fence on the fence assembly of Sato (e.g., by replacing fence 3 with a fence assembly such as that disclosed by O'Banion or EP '300) for the well known benefits including those described above.

Regarding claim 17, the distance between the first plane (defined by the movable fence which is the same plane as that defined by the fixed fence) and the second plane (defined by the auxiliary fence) is adjustable and thus is fully capable of being adjusted to the claimed distance.

Response to Arguments

9. Applicant's arguments filed November 29, 2006 have been fully considered but they are not persuasive.

In the paragraph bridging pages 4-5 of the response, applicant argues that the claim has been amended to define the fixed fence, the movable fence and the auxiliary fence are disposed on the same side of the blade. However, as described in the prior art rejections above, the prior art still meets such a condition, and particularly the further condition that when the movable fence (e.g., 60), the auxiliary fence (e.g., 80) is allowed to contact the workpiece.

In the second paragraph on page 5 of the amendment, the Examiner respectfully disagrees with applicant's position, and submits that the prior art meets the claimed invention and explained in further detail in the prior art rejections above.

In the fourth paragraph on page 5 of the response, the Examiner respectfully disagrees with applicant's conclusion and submits that the prior art still meets the claimed invention as explained in further detail in the prior art rejections above.

In the third paragraph on page 6 of the response, applicant argues that "Sato does not suggest the desirability of providing an auxiliary fence behind a fixed fence." The Examiner respectfully submits that no modification of the structure of Sato is required. Sato is fully capable of being adjusted to the claimed position with the structure disclosed therein.

In the last two paragraphs on page 6 and the first paragraph on page 7 of the response, applicant further argues that there is no suggestion to modify Sato such that feature 37 is behind the fixed fence. First, it is noted that feature 37 is considered to be "behind" the fixed fence when it is in a retracted position with respect to the fixed fence, for example in the view shown in Figure 12. Sato clearly discloses that feature 37 is fully capable of being adjusted to a position using the disclosed structure without modification of the disclosed structure. The specific position to which feature 37 is adjusted is considered to be a functional recitation of intended use of the device of Sato. That is, while the structure of Sato is disclosed as being used in a different manner, the structure of Sato is fully capable of being used in a different manner; for example, adjusting feature 37 to a position that is behind the fixed fence.

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In the second and third paragraphs on page 7 of the response, applicant argues that modifying Sato would change the principles of operation. The Examiner respectfully disagrees with applicant's conclusion. As explained above, the apparatus disclosed in Sato requires no modification of the disclosed structure to meet the claimed invention. Rather, the apparatus of Sato merely requires adjustable structure to be set at a specific orientation within a range of orientations to which Sato can be adjusted.

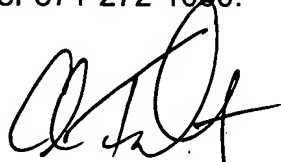
For at least the above reasons, the prior art rejections must be maintained.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark F. Dexter whose telephone number is (571)272-4505. The examiner can normally be reached on Mondays, Tuesdays, Thursdays and Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on (571)272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Clark F. Dexter
Primary Examiner
Art Unit 3724

cfd

December 18, 2006